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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,309

03/22/2004

Michael J. Czaplicki

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11/22/2006

DOBRUSIN & THENNISCH PC

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/806,309	Applicant(s) CZAPLICKI ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20, 24, 25, 27, 28, 30, 31, 33, 34 and 44-62 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20, 24, 27, 28, 30, 31, 34, 44, 45 and 47-53 is/are allowed.
- 6) ☒ Claim(s) 33, 46 and 54-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>November 10, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

1. The restriction and election of species requirement has been made Final in the non-Final rejection mailed August 23, 2006 (page 3, line 5). Any further challenge of the requirement must be made by petition. Claims 25 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on July 13, 2006.
2. The 35 U.S.C. 102(b) rejection over Patel Patent No. 6,136,732 or Japanese Patent No. 56-118816 as well as the 35 U.S.C. 103(a) rejection over Patel in view of the Japanese patent have been overcome by the insertion of the limitation of claim 23 into independent claim 20 wherein the correspondence components include an epoxy resin. The aforementioned limitation along with the confinement of the base material to an expandable material as denoted in new claims 44, 45 and 47-53 are allowable for the reasons espoused in the non-Final rejection on page 5, paragraph 6. Accordingly, claims 20, 24, 27, 28, 30, 31, 34, 44, 45 and 47-53 are deemed to be allowable.
3. The closest prior art reference cited in the Information Disclosure Statement filed November 10, 2006 is Hable et al. Publication No. 2004/0076831 wherein the non-tacky coating or film (page 1, paragraph 10) containing a water-based emulsion of an epoxy resin is not in the claimed form of a powder.
4. The word "includes" is mistyped in claim 60, line 1.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 33 and 55-62 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a base material including an epoxy resin (page 4, line 5 and page 6, lines 1-20), does not reasonably provide enablement for thermosettable materials in general as denoted in claims 33 and new independent claim 55, lines 10-11. Furthermore, the specification only enables an epoxy resin as a thermosettable material for the polymer powder on page 7, line 30 and page 8, line 22 to page 9, line 18. The term "thermosettable material" embraces an exhaustive variety of curable natural and synthetic components not disclosed for either the base material nor the polymer powder.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 54 and 62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

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6. Nowhere in the specification, particularly page 7, line 24 to page 10, line 11 wherein the powder and correspondence components are discussed, is there any support for the claimed species of acetate or acrylate correspondence components.

7. Claim 46 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the contacting of the non-tacky surface of the synthetic material by either an individual or a machine, does not reasonably provide enablement for the contacting by a combination of an individual and a machine on page 13, lines 29-30. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712